

REMARKS/ARGUMENTS

In the Office Action mailed March 20, 2009, claims 1-3, 5-13, and 15-19 were rejected. Additionally, the specification was objected to. In response, Applicants hereby request reconsideration of the application in view of the below-provided remarks. No claims are amended, added, or canceled.

Objections to the Specification

The Office Action suggests that section headings be added to the specification, according to the guidelines set forth in the MPEP. Applicants note that the suggested section headings are not required and, hence, Applicants respectfully decline to amend the specification to include the indicated section headings.

Claim Rejections under 35 U.S.C. 103

Claims 1-3, 5-13, and 14-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Roz (U.S. Pat. No. 6,462,647, hereinafter Roz) in view of Yamagishi (U.S. Pat. No. 6,982,747, hereinafter Yamagishi). However, Applicants respectfully submit that these claims are patentable over Roz and Yamagishi for the reasons provided below.

Independent Claim 1

Applicants submit that claim 1 is patentable over the combination of Roz and Yamagishi because the combination of cited references does not teach all of the limitations of the claim. Claim 1 recites:

A circuit for a first communication partner appliance designed for contactless communication within a communication system comprising at least one second communication partner appliance in which circuit either an active send mode or a passive send mode may be activated, the circuit comprising:

terminal means to transmit carrier signals usable for contactless communication;

communication signal processing means to activate an active send mode and a passive send mode, wherein the active send mode uses a carrier signal generated with the communication signal processing means for the contactless communication, and the passive send mode uses a carrier signal generated with a

second communication partner appliance and received by the circuit via the terminal means for the contactless communication;

determination means to determine first energy source information which comprises at least one parameter of at least one energy source serving to supply the circuit with electrical energy;

an external energy source information identification stage to identify second energy source information which comprises at least one parameter of at least one energy source serving to supply a circuit of the second communication partner appliance with electrical energy; and

decision means to form a decision result based on the first and second energy source information from the first and second communication partner appliances, wherein the decision result influences which send mode is to be activated in the circuit of the first communication partner appliance. (Emphasis added.)

In contrast, the combination of Roz and Yamagishi does not teach all of the limitations of the claim because the combination of cited references does not teach a circuit with an external energy source information identification stage to identify second energy source information which includes a parameter of an energy source which supplies the circuit with electrical energy. For reference, the Office Action acknowledges that Roz does not teach the indicated language of the claim. Hence, the Office Action relies on Yamagishi as purportedly teaching the indicated limitation. In particular, the Office Action states:

Yamagishi teaches a communication feature the power source status of another device as communication partner (S204-S216 in Fig. 9, column 17 line 12 to column 19 line 15), which provides a wireless device decisive info for determining following communicative operation. One of ordinary skill in the art would have obviously incorporated such feature of Yamagishi into the apparatus of Roz for giving the circuit decisive info on send mode selection for communication. Because the circuit of Roz would have to use active send mode if the second communication partner appliance is low power stage. Conversely, the circuit of Roz could use passive send mode with conserving battery power if the second communication partner appliance is in high power stage. Office Action, 3/20/09, page 5 (emphasis added).

However, the assertions in the Office Action and the teachings of Yamagishi do not address the full scope of the claim. Yamagishi is generally directed to communicating an operating status of a portable telephone to an electronic camera, and vice versa. Yamagishi, col. 1, lines 6-11. For reference, Yamagishi refers to the portable telephone as a communication apparatus (Yamagishi, col. 1, lines 44-49), and refers to

the electronic camera as an image sensing apparatus (Yamagishi, col. 1, lines 22-25). The image sensing apparatus and communication apparatus exchange data including commands and images by radio communication. Yamagishi, col. 5, lines 51-55. In particular, the communication apparatus (i.e., portable telephone) transmits an operating status of the communication apparatus to the image sensing apparatus (i.e., electronic camera), and the image sensing apparatus transmits an operating status of the image sensing apparatus to the communication apparatus. Yamagishi, col. 2, lines 14-32.

Although Yamagishi describes functionality for the telephone and camera to send corresponding operating statuses to each other so that a user can be notified of the status of one device while using the other device, it should be noted that the telephone and camera are not communication partners which supply electrical energy to each other, within the context of the claim. More specifically, the telephone does not supply electrical energy to the camera to power the operations of the camera. Similarly, the camera does not supply electrical energy to the telephone to power the operations of the telephone. Thus, even though the telephone and camera send operating statuses to each other, the telephone and camera are not communication partners which supply electrical energy to each other.

Since the telephone and camera are not communication partners which supply electrical energy to each other, the communication of operating statuses transmitted between the telephone and camera cannot be construed as a parameter of an energy source which supplies electrical energy to another device. Therefore, Yamagishi does not teach a circuit with an external energy source information identification stage to identify second energy source information which includes a parameter of an energy source which supplies the circuit with electrical energy, as recited in the claim.

Moreover, the proposed combination of the teachings of Yamagishi with Roz is improper because the reasoning presented in the Office Action in support of the proposed combination is based on impermissible hindsight. Specifically, the reasoning presented in the Office Action to combine the cited references merely employs impermissible hindsight because it relies on a motivation of the present application, without providing any other evidence of disclosure in the cited references or evidence of common knowledge. In support of the rejection, the Office Action states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the circuit of Roz with receiving power source status of communication partner appliance taught by Yamagishi into taking power source info of both internal and external for send mode selection, in order to make more accurate send mode selection for following communicative operations. Office Action, 3/20/09, page 5 (emphasis added).

To the extent that Roz might make some type of selection of the send mode (active or passive) to be used, the selection described in Roz does not take into account a parameter of an energy source serving to supply a circuit of another communication partner appliance with electrical energy. This is acknowledged in the Office Action because the Office Action recognizes that Roz does not teach such functionality.

Therefore, in the absence of some additional reasoning, it appears that the only basis for the asserted conclusion—that it would be “more accurate” to use information from another communication partner in order to select a send mode—stems directly from the disclosure of the present application. In fact, the Office Action does not attempt to identify any rationale to support the assertion that using the information of another device might result in more accurate send mode selections. Rather, the primary reason for the proposed combination is merely derived from the present application, which states that:

By providing the measures according to the invention, both for a circuit and for a communication partner appliance as well as for a method according to the invention, that the send mode of the circuit of the communication partner appliance may be selected, after initiation of a communication sequence between two such communication partner appliances, as a function of the energy supply conditions for the circuit, such that, as a function of at least one parameter of the energy source provided for supplying the circuit, the send mode most favorable in the particular instance may be activated. In this way, advantageous mode management is achieved for sending communication, whereby operating reliability is improved considerably in the case of sending communication.

Present Application, page 4, lines 1-10 (emphasis added).

While the present application does not explicitly use the phrase “more accurate,” as stated in the Office Action, the statement of more accurate operation is merely a generalization of the specific advantages achieved by embodiments described in the present application, namely, mode management and improved reliability. Therefore, the

assertion that it would be obvious to combine the teachings of Yamagishi with Roz in order to make a more accurate send mode selection is not supported by any specific evidence other than the disclosure of the present application. Therefore, since the only specific rationale for implementing the claimed embodiments is found in the present application, the reasoning presented in the Office Action to combine the cited references merely employs impermissible hindsight that is ultimately based on the disclosure of the present application.

For the reasons presented above, the combination of Roz and Yamagishi does not teach all of the limitations of the claim because Yamagishi does not teach a circuit with an external energy source information identification stage to identify second energy source information which includes a parameter of an energy source which supplies the circuit with electrical energy, as recited in the claim. Additionally, as a separate basis for patentability, the proposed combination of the teachings of Yamagishi with Roz is improper because the proposed combination is based on impermissible hindsight, rather than some articulated reasoning with some rational underpinning. Accordingly, Applicants respectfully assert claim 1 is patentable over the proposed combination of Roz and Yamagishi.

Independent Claim 11

Applicants respectfully assert independent claim 11 is patentable over the combination of cited references at least for similar reasons to those stated above in regard to the rejection of independent claim 1. Claim 11 recites subject matter which is similar to the subject matter of claim 1 discussed above. Although the language of claim 11 differs from the language of claim 1, and the scope of claim 11 should be interpreted independently of other claims, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 1 also apply to the rejection of claim 11.

Dependent Claims

Claims 2, 3, 5-10, 12, 13, and 15-19 depend from and incorporate all of the limitations of the corresponding independent claims 1 and 11. Applicants respectfully assert claims 2, 3, 5-10, 12, 13, and 15-19 are allowable based on allowable base claims.

Additionally, each of claims 2, 3, 5-10, 12, 13, and 15-19 may be allowable for further reasons, as described below.

Claims 9 and 19

In regard to the rejections of claims 9 and 19, Applicants respectfully submit the rejections of claims 9 and 19 are improper because the Office Action does not establish *prima facie* obviousness. In order to establish a *prima facie* rejection of a claim under 35 U.S.C. 103, the Office Action must present a clear articulation of the reason why the claimed invention would have been obvious. MPEP 2142 (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. __ (2007)). The analysis must be made explicit. *Id.* Additionally, rejections based on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Here, the Office Action relies on the teachings of Roz. However, the Office Action fails to explain why the limitations of claims 9 and 19 would have been obvious. Although the Office Action asserts a conclusion that the limitations of claims 9 and 19 would have been obvious, the Office Action does not even attempt to address all of the specific language of the claim. In particular, the Office Action does not address how or why it might have been obvious to facilitate termination and subsequent restart of a communication protocol, as recited in the claim. Although the Office Action concludes that the circuit of Roz would use the same passive send mode with the same previously used response communication when a second communication partner appliance sends another interrogation signal, this conclusion does not address termination and subsequent restart of a communication protocol. In other words, the conclusion does not provide an explanation or any reasoning in support of the assertion of obviousness regarding termination and subsequent restart of a communication protocol. More specifically, the Office Action does not even attempt to explain what teachings of Roz or of the common knowledge might render the indicated limitations obvious to one of skill in the art. Thus, the Office Action asserts mere conclusory statements which are not supported by some articulated reasoning with some rational underpinning.

Therefore, the Office Action fails to establish *prima facie* rejections for claims 9 and 19 because the Office Action does not even attempt to explain what evidence or reasoning might render the indicated limitations obvious. Therefore, the rejections of claims 9 and 19 are improper because the Office Action fails to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully submit that the rejections of claims 9 and 19 under 35 U.S.C. 103(a) should be withdrawn.

CONCLUSION

Applicants respectfully request reconsideration of the claims in view of the remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-4019** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **50-4019** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

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